REMARKS

Office action summary

Claims 19-28 are pending in the present application. As of the office action of January 26, 2009 ("Office Action"), claims 1-18 and 29-32 stood withdrawn. Claims 19-21, 24-25, and 27-28 are presently amended. Claims 1-18 and 29-32 are presently canceled. Claims 33-47 are presently added with claims 33, 38, and 43 being independent claims. Thus, following entry of the present amendments, claims 19-28 and 33-47 will be pending.

The following objections and rejections were made in the Office Action:

- Claims 19-20 and 24-27 were rejected under 35 USC § 102(a) as being anticipated by Alexander et al, US Patent 6,177,931 ("Alexander").
- Claims 21-22 were rejected under 35 USC § 103(a) as being unpatentable over Alexander.
- Claim 23 was rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Tsuchiya et al, "High Density Digital Videodisc Using 635mm Laser Diode", IEEE Transactions on Consumer Electronics, Vol. 40, No. 3, August 1994 ("Tsuchiya").
- Claim 28 was rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Fisher et al, US Patent 5,835,896 ("Fisher").

The amendments and rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants' undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

Telephonic interview

On March 31, 2009, applicants' undersigned attorney and Examiner Nguyen-Ba conducted a telephonic interview. Applicants' undersigned attorney would like to thank the examiner for granting the interview. During the interview, applicants' proposed amendments were discussed with respect to the cited art of record. Any further substance of the interview is incorporated into the remarks below.

Claim cancellations and amendments

Claims 1-18 and 29-32 stood withdrawn as of the mailing of the Office Action. Applicants presently cancel claims 1-18 and 29-32 without prejudice, reserving the right to file those claims in a subsequent application.

Without conceding the propriety of the rejections made in the Office Action, in an effort to further prosecution of the present case, applicants presently amend claims 19-21, 24-25, and 27-28. The patentability of these claims in light of the cited art is discussed below.

Rejections under 35 USC §§ 102(a) and 103(a)

Claims 19-20 and 24-27 stand rejected under 35 USC § 102(a) as being anticipated by Alexander. Claims 21-22 stand rejected under 35 USC § 103(a) as being unpatentable over Alexander. Claim 23 stands rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Tsuchiya. Claim 28 was rejected under 35 USC § 103(a) as being unpatentable over Alexander in view of Fisher.

Claim 19, as presently amended, recites, in part:

> determining, based on a subscription level of a user, that display of an advertisement is appropriate during a first insertion point;
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> displaying at least one of the selected advertisements during the first insertion point;
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> determining, based on the subscription level of the user, that display of an advertisement is not appropriate during a second insertion point; and
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> continuing display of the entertainment content without displaying an advertisement during the second insertion point.

Applicants' provide a non-liming example of determining whether an advertisement is appropriate based on the subscription level of the user. (See para. 0037.) There, the disclosure indicates that if the user is paying a higher subscription rate, it may not be appropriate to display advertisements during one of the insertion points in the entertainment content. (*Id.*) By implication, if the customer is paying a lower subscription rate, it may be appropriate to display one or more advertisements at an insertion point in the entertainment content.

The examiner cited to several portions of Alexander which relate to targeting advertisements to specific consumers based on the consumer's characteristics. (See

Alexander, col. 6, ll. 52-59; col. 28, line 11 – col. 30, line 44.) More specifically, Alexander teaches "[c]reation of a viewer's profile" and "[u]tilization of viewer profile information to customize various aspects of the EPG [electronic programming guide]" and "[u]tilization of viewer profile information to provide customized presentation of advertising to the viewer." (Alexander, col. 6, ll. 85-59.) In more detail, Alexander discusses that the viewer profile includes information such as the user's zip code, the television used by the user, the favorite channels and programs, and similar information. (Col. 28, ll. 12-21.) The user profile information can be used to tune the TV to a certain channel or to customize a program guide. (Col. 30 line 45 – col. 32 line 21.) The user profile information can also be used to preset targeted advertisements to the user, such as advertisements to local restaurants, or advertisements directed to the user's interests. (Col. 32, ll. 22-54.) However, applicants can discern no teaching in the cited portions of the cited art which teaches that display of an advertisement may not be appropriate at a place in the content where an advertisement would normally be displayed. Thus, while Alexander may generally relate to using a user profile for customizing a television display, Alexander fails to teach or suggest determining whether it is appropriate to display an advertisement based on the subscription of the user. For at least this reason, applicants submit that claim 19 is patentably defined over the cited art. Accordingly, applicants request withdrawal of the rejection of claim 19 under 35 USC § 102(a).

Claims 20-28 depend, directly or indirectly, from claim 19. Inasmuch as claims 20-28 depend from independent claims which are patentably defined over the cited art, applicants submit that claims 20-28 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 20-28 under 35 USC §§ 102(a) and 103(a).

New claims

Claims 33-47 are presently added with claims 33, 38, and 43 being independent claims. Independent claims 33, 38, and 43 recited subject matter similar to the recitations of claim 19 discussed above. For at least the reasons discussed above regarding the patentability of claim 19, applicants submit that claims 33, 38, and 43 are patentably defined over the cited art. Claims 34-37, 39-42, and 44-47 depend, directly or indirectly, from claims 33, 38, and 43. Inasmuch as claims 33, 38, and 43 depend from independent claims which

are patentably defined over the cited art, applicants submit that claims 33, 38, and 43 are patentably defined over the cited art.

For the foregoing reasons applicants submit that new claims 33-47 are patentably defined over the cited art, and, therefore, in condition for allowance.

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 19-28 and 33-47 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

Date: April 22, 2009

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